

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DELMER G. PARKER

Appeal No. 2001-2406
Application 09/307,445

ON BRIEF

Before JERRY SMITH, BARRY and LEVY, Administrative Patent Judges.
JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-5, which constitute all the claims in the application. An amendment after final rejection was filed on October 12, 2000 but was denied entry by the examiner.

The disclosed invention pertains to a fusing apparatus for heating and permanently fusing toner powder images onto an image carrying sheet.

Representative claim 1 is reproduced as follows:

1. A fusing apparatus for heating and permanently fusing toner powder images onto an image carrying sheet; the fusing apparatus comprising;

(a) a pressure roller;

(b) a closed loop magnetic flux carrying member positioned adjacent said pressure roller and including a first side and a second side opposite said first side, said first side being located between said pressure roller and said second side;

(c) an electrically conductive wire wound about said second side forming a primary transformer coil, said primary transformer coil having N1 number of turns and being connectable to an AC power supply source for inductively transferring AC electric energy to a secondary coil wound around said first side; and

(d) a rotatable fuser roller forming a fusing nip with said pressure roller, said rotatable fuser roller having a rigid non-conductive core comprising a ceramic tube and a conductive metal sleeve that is shrink-fitted onto said ceramic tube for minimizing the thermal time constant of said rotatable fuser roll, said rotatable fuser roller being mounted around said first side of said closed loop magnetic flux carrying member and forming a secondary transformer coil inductively coupled to said primary transformer coil, and said conductive layer being inductively heated by power dissipated by current induced therein when said primary transformer coil is connected to said AC power supply source.

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The examiner relies on the following reference:

Kadowaki et al. (Kadowaki) JP 58-35568 Mar. 2, 1983

Claims 1-5 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Kadowaki¹ taken alone.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

¹ Our understanding of Kadowaki is based on a translation provided by a contractor of the United States Patent and Trademark Office. A copy of this translation is attached to this decision.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-5. Accordingly, we reverse.

Appellant has nominally indicated that for purposes of this appeal the claims stand and fall separately because each of dependent claims 2-5 can be rewritten separately as an independent claim [brief, page 5]. The fact that dependent claims can be rewritten separately as independent claims does not constitute an argument in support of separate patentability. In order to have a claim considered separately for patentability, substantive arguments must be presented as to why the limitations of that claim provide patentability independent of the other argued claims. Appellant has provided substantive arguments only with respect to independent claim 1. Accordingly, all the claims before us will stand or fall together with independent claim 1. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983).

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In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts

to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived by appellant [see 37 CFR § 1.192(a)].

With respect to representative, independent claim 1, the examiner finds that Kadowaki teaches everything claimed except for the conductive metal layer being shrink-fitted onto the insulating core. The examiner asserts that the method of forming the thin conductive layer onto the fusing roller is given little patentable weight in apparatus claims without evidence showing an unobvious difference [answer, pages 4-5].

Appellant argues that the limitation "having a shrink fit on" [sic, sleeve that is shrink-fitted onto] is an apparatus limitation and not a method limitation [brief, page 8].

Appellant also argues that the specification has clear support for the criticality of the shrink-fit limitation [id., pages 8-9]. Appellant argues that there is no teaching or suggestion in Kadowaki that the conductive layer is shrink-fitted onto the fusing tube or any recognition of the problem solved by appellant's invention [id., pages 9-11].

The examiner responds that the phrase "sleeve that is shrink-fitted onto" is a process limitation and not a structural limitation. The examiner asserts that the art is substantially the same as the claimed invention, and the burden has shifted to appellant to come forth with evidence establishing an unobvious difference. The examiner also questions the criticality of the shrink-fit limitation and asserts that the problem could have been solved without the shrink-fitting [answer, pages 5-6].

Appellant responds by repeating the argument that the shrink-fit limitation is a structural limitation and not a process limitation and that the limitation serves a critical purpose as stated in the claim. Appellant also argues that it was improper for the examiner to substitute his beliefs as to what is critical for the claimed invention [reply brief].

We will not sustain the examiner's rejection of claims 1-5 based on this record. In considering the claimed phrase "a conductive metal sleeve that is shrink-fitted onto said ceramic tube," the examiner erred in treating the phrase as a product by process limitation, and therefore, ignoring the shrinking-fitted aspect of the recitation. The application of product by process considerations to a claimed product requires that the structure of the claimed product be essentially the same as the structure of the applied prior art. When this finding is supported by the evidence, it shifts the burden to an applicant to demonstrate that the claimed structure is, in fact, different from the applied prior art in its structural properties. We disagree with the examiner's assertion that the claimed sleeve that is shrink-fitted onto the ceramic tube is essentially the same structure as the conductive metal sleeve of Kadowaki. We agree instead with appellant's argument that a shrink-fitted connection between two elements describes a structural arrangement rather than a process arrangement. Although the phrase "shrink-fitted" may describe how the two elements came to be connected together, the phrase also describes a structural relationship between the two elements which cannot be ignored in considering the obviousness of the claimed invention. Since we find that the claimed phrase quoted

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above constitutes a specific structural connection, appellant is not required to demonstrate any criticality or prove that the claimed structure is non-obvious over the applied prior art.

As a general rule, ignoring claim recitations when making prior art rejections is not a good idea. In this case the examiner should have considered (and should still consider) whether it would have been obvious to the artisan to modify the conductive sleeve 19 of Kadowaki so that it is shrink-fitted onto the insulating core. We note that there is no evidence on this record which even mentions the use of a shrink-fitted connection. Therefore, there is no basis on this record for any consideration of the obviousness of a shrink-fitted connection.

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In summary, we have not sustained the examiner's rejection of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-5 is reversed.

REVERSED

JERRY SMITH)	
Administrative Patent Judge)	
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LANCE LEONARD BARRY)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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STUART S. LEVY)	
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